



BP9806US-CP1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No: 09/520,760 Confirmation No. 9118
Date Filed: March 7, 2000
Application Title: Non-Nucleic Acid Probes, Probe Sets, Method and Kits
Pertaining To The Detection Of Human Chromosomes X, Y,
1, 2, 3, 6, 10, 11, 12, 16, 17, and 18
Applicant: Krishan L. Taneja
Group Art Unit: 1634
Examiner: Jehanne E. Souaya
Action Date: April 21, 2003
Action Type: First Office Action On Merits – NON-FINAL
Certified Mail No.: 7003 0500 0000 1738 3623

Certificate of Mailing Pursuant to:
37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 9th day of October, 2003.

Brian D. Gildea
Reg. No. 39,995

Reply To Office Action

Commissioner for Patents
Dear Sir or Madam:

A petition under 37 C.F.R. § 1.136(a) for an automatic three-month extension of time to reply to the present office action has been included with the papers accompanying this submission so please consider the following response to the Office Action mailed on April 21, 2003.

I. ACTION SUMMARY

Claims 1, 2, 10, 11, 12, 29, 31, 33, 34, 38, 39, 40, 45, 47, 49, 50, 55, 56, 64, 65, 66, 78, 79 and 80 stand pending in the application. Claims 1, 2, 29, 31, 33, 34, 38, 39, 40, 45, 47, 49, 50, 55, 56, 64, 65, 66, 78, 79 and 80 stand withdrawn from consideration by the Examiner. Only claims 10-12 stand under consideration in this Office Action. Claims 10-12 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 10-12 stand rejected under 35 U.S.C. § 102(a) and 35 U.S.C. §102(e) as being anticipated by Hyldig-Nielsen et al. (US 5,985,563). No claim stands allowed.

II. FORMAL MATTERS

The Examiner is thank for her return of the PTO-Form 1449 for the documents submitted on May 22, 2001.

At page 3 of the Office Action, the Examiner discusses a conversation that is memorialized in the Interview Summary Record attached to the Office Action. It is agreed that all 118 probe sequences are selected provided however that Applicant continues to traverse the restriction/election requirement.

III. AMENDMENT

i. *Introductory Comments*

PLEASE ENTER THE FOLLOWING AMENDMENT WITHOUT PREJUDICE OR DISCLAIMER. Applicant reserves the right to file a divisional or continuation application to the originally filed claims.

Please amend the claims as follows: